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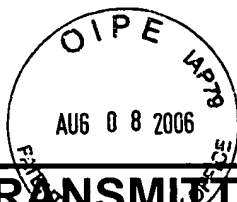
IFW 2820

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application No.	09/751,214
	Filing Date	December 29, 2000
	First Named Inventor	Neogi
	Art Unit	2826
	Examiner Name	Leonardo Andujar
Total Number of Pages in This Submission		Attorney Docket Number 42390P9975

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 10px;">Return Post Card Application for Adjustment of Patent Term Under 37 CFR §1.705(b). pgs.13.</div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Paul A. Mendonsa, Reg. No. 42,879 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	August 2, 2006

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Typed or printed name	Julie Dussault		
Signature		Date	August 2, 2006



FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

Complete if Known

Application Number	09/751,214
Filing Date	December 29, 2000
First Named Inventor	Neogi
Examiner Name	Leonardo Andujar
Art Unit	2826
Attorney Docket No.	42390P9975

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☒ None ☐ Other (please identify): _____
☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayment of fee(s) ☒ Credit any overpayments
under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

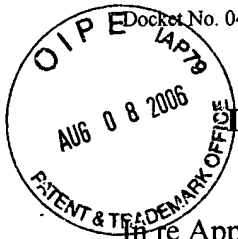
FEE CALCULATION

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
Other fee (specify) Application for Adjustment of Patent Term Under 37 CFR § 1.705(b)...					0.00
SUBTOTAL (2)				(\$)	0.00

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Paul A. Mendonsa	Registration No. (Attorney/Agent)	42,879	Telephone	(503) 439-8778
Signature		Date	08/02/06		



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Neogi, et al.

Serial No.: 09/751,214

Filed: December 29, 2000

For: IC Package Pressure
Release Apparatus and Method

Attorney Docket No.: 042390.P9975

Examiner: Leonardo Andujar

Group Art Unit: 2826

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR ADJUSTMENT OF PATENT TERM UNDER 37 CFR §1.705(b)

Dear Examiner,

In response to the Notice of Allowance mailed May 18, 2006, applicants respectfully petition and apply under 37 CFR §1.705(b) for an Adjustment of Patent Term, on grounds detailed in 35 USC §154(b)(1)(A)(iv) and 37 CFR §1.702(a)(4).

Statement of Facts begins at **pg. 2**.

Conclusion begins at **pg. 13**.

I, Julie Dussault, hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 2, 2006.


(Signature of person mailing correspondence)

STATEMENT OF FACTS

Correct Patent Term Adjustment and Basis under 37 CFR §1.702 for Adjustment

The Notice of Allowance mailed May 18, 2006, asserts that the applicants are entitled to an Adjustment of Patent Term for this application equal to 0 (zero) days. Applicants respectfully disagree with the assertion, and hereby apply for an Adjustment of Patent Term under 35 USC §154(b)(1)(A)(iv) and 37 CFR §1.702(a)(4). Applicants respectfully submit that as of June 17, 2005, applicants had paid the issue fee required under 35 USC 151, and all outstanding requirements were satisfied on a patent application filed after May 29, 2000. The Office thereafter failed to issue a patent on the allowed claims on or before October 17, 2005, a date four months after the payment of the required issue fee and the satisfaction of all outstanding requirements. Therefore, applicants claim that the grounds entitling applicants to a patent term adjustment under the Patent Term Guarantee Act of 1999, 35 USC §154(b)(1)(A)(iv), and 37 CFR §1.702(a)(4), were satisfied as of October 17, 2005.

Applicants respectfully submit that the correct patent term adjustment is that provided under 35 USC §154(b)(1)(A) and 37 CFR §1.703(a)(6). Under these sections, the adjustment pursuant to 37 CFR §1.702(a) is equal to the number of days beginning on October 17, 2005, which is four (4) months after June 17, 2005, the date on which the issue fee was paid and all outstanding requirements were satisfied, and ending on the issue date of a patent on the allowed claims. This term is the applicants' claim of right in this application.

In the following sub-sections of this response, applicants will establish the basis for their application under the claim of right to patent term extension, and respectfully submit that the claim is fully supported by the rules and facts as presented below.

(1) The ‘Withdrawal from Issue under 37 CFR §1.313’ was Improper for not Complying with the Requirements Under CFR §1.313(b) or (c)

Applicants base their application for patent term adjustment in the first instance on non-compliance by the Patent Office (Office) with the rules for “Withdrawal from Issue at the Initiative of the Office” after payment of the issue fee by the applicant under 37 CFR 1.313, as provided under 35 USC 151. Specifically, the applicants respectfully submit that the withdrawal from issue was improper because the applicant did not petition for withdrawal of the application under 37 CFR §1.313(c) and the patent office has not complied with the requirements for withdrawal from issue under 37 CFR §1.313(b).

First, it is clear that the withdrawal was a ‘Withdrawal from Issue’ under 1.313 because the notice is explicitly so labeled. However, the notice fails to state whether the withdrawal is taken under 37 CFR §1.313(b) or §1.313(c). Therefore, both are discussed herein. Second, it is clear that the issue fee was paid by the applicant prior to the withdrawal from issuance, because the issue fee was paid on June 17, 2005, and the notice of withdrawal from issuance was sent by the Office on January 11, 2006.

Regarding withdrawal under 37 CFR §1.313(c), none of the requirements for withdrawal under this section were fulfilled. 37 CFR §1.313(c) clearly states that “Once the issue fee has been paid, the application *will not* be withdrawn from issue upon petition by the applicant for any reason except [those reasons provided in (1)-(3)]”, (emphasis provided). The applicants did not petition the Office under 37 CFR §1.313(c), and therefore, none of the reasons under 37 CFR §1.313(c)(1)-(3) were provided in a petition by applicants. Therefore, the withdrawal was not proper under CFR §1.313(c), and was not a withdrawal from issue initiated by applicants.

Regarding withdrawal under 37 CFR §1.313(b), it is clear that the withdrawal from issuance was initiated by the patent office, because it was not initiated by the applicant (as detailed above), and the only other method permitted for withdrawal from issuance under 37 CFR §1.313 is pursuant to 37 CFR §1.313(b). However, the Office has not complied with the requirements set forth under 37 CFR §1.313(b).

First, MPEP 1308 §II states, “Any notice withdrawing an application from issue after payment of the issue fee *must* specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (4) exists and thus warrants withdrawal of the application from issue”, (emphasis provided). Under 37 CFR 1.313(b)(1) through (4) specify four conditions for withdrawing an application from issue after issue fee payment; (1) a mistake on the part of the Office; (2) a violation of 37 CFR 1.56 or illegality in the application; (3) unpatentability of one or more claims; or, (4) for interference. Sections 37 CFR 1.313(b)(1), (2) and (4) will now be discussed in turn, followed by a detailed examination of 37 CFR §1.313(b)(3).

Mistake on the Part of the Patent Office - 37 CFR § 1.313(b)(1)

The Notice failed to assert or identify any mistake on the part of the Office. Rather, the Notice only states, “The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner”, (Notice, mailed January 11, 2006). “Reopening of prosecution” does not indicate a mistake on the part of the patent office, and is not a condition permitting withdrawal under CFR 1.313(b). Further, the Examiner did not communicate with the applicants regarding any mistakes on the part of the patent office in the subsequent Office Action mailed on March 27, 2006 (Office Action) or in any other subsequent communication with the applicants. Therefore, 37 CFR 1.313(b)(1) does not apply, and fails to form any part of the basis for the CFR 1.313(b) withdrawal.

Violation Of 37 CFR 1.56 Or Illegality In The Application - 37 CFR § 1.313(b)(2)

The Notice failed to assert or identify any violation of 37 CFR 1.566 or illegality in the application. “Reopening of prosecution” does not indicate or specify a violation of 37 CFR 1.56 or illegality in the application, and the Examiner failed to communicate any violation of 37 CFR 1.566 or illegality in the application to the applicants in the Office Action or in any other subsequent communication with the applicants. Therefore, 37 CFR 1.313(b)(2) does not apply, and fails to form any part of the basis for the CFR 1.313(b) withdrawal.

Interference - 37 CFR § 1.313(b)(4)

The Notice failed to assert or identify any interference action. “Reopening of prosecution” does not indicate an interference action, and the Examiner failed to communicate the presence of any interference action to the applicants in the Office Action or in any other subsequent communication with the applicants. Therefore, 37 CFR 1.313(b)(4) does not apply, and fails to form any part of the basis for the CFR 1.313(b) withdrawal.

Unpatentability of one or more claims - 37 CFR § 1.313(b)(3)

The Notice failed to assert or specify that one or more of the allowed claims were unpatentable. “Reopening of prosecution” does not specify that one or more of the claims are unpatentable, and is not a condition permitting withdrawal under CFR 1.313(b). Therefore, because “[a]ny notice withdrawing an application from issue after payment of the issue fee *must* specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (4) exists and thus warrants withdrawal of the application from issue”, and the notice failed to so specify, applicants respectfully submit the Notice is improper on this basis.

Applicants further submit that the statement in the Notice that, “[t]he reasons therefore will be communicated to you by the examiner” also fails to comply with the requirements for a proper notice, and indicate that the withdrawal from issue itself is improper.

MPEP 1308 permits that:

An application may be removed from the Office of Patent Publication, *without it being withdrawn from issue* under 37 CFR 1.313(b), to permit the examiner to consider. . . whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue, (MPEP 1308, §II)(emphasis provided)

Further, this same section unequivocally states, “Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee at the initiative of the Office are . . . (B) to permit the examiner to consider whether one or more claims are unpatentable”, (emphasis original). From these two sections, it is clear that the decision as to unpatentability of one or more allowed claims, after payment of the issue fee, *must* be made prior to proper and permissible withdrawal from issuance under 37 CFR 1.313(b).

As noted, the Notice failed to properly assert that “one or more claims are unpatentable”, so the notice itself does not support an assertion that such determination was made *prior to* the decision to withdraw from issuance as required under 37 CFR 1.313(b). Rather, the Notice improperly defers to a later and separate notification by the examiner as to the basis for the withdrawal from issue and the reopening of prosecution. According to MPEP 1308.01 regarding ‘Rejection After allowance [R-2]’, “After the TC Director has withdrawn the application from issue, the examiner will prepare< an Office action *stating that the application has been withdrawn from issue*, citing the new reference, and rejecting the claims met thereby”, (emphasis added). The Office Action failed entirely to mention or address the withdrawal from issue, so failed to comply with MPEP 1308.01 and with 37 CR §1.313(b).

The first communication from the Examiner following the Notice was a ‘non-final’ office action (Office Action) mailed on March 27, 2006. In Section 1, page 2 of the office action, the Examiner asserted that the office action is pursuant to a Request for Continued Examination (RCE) submitted by the applicant on August 30, 2004. This assertion is errant and irrelevant to the withdrawal from issuance, since a RCE can *only* properly form the basis for withdrawal from issuance following payment of the issue fee under 37 CFR 1.313(c), when cited in a petition for withdrawal from issuance submitted by the applicant. As discussed above, no such petition was submitted to the office by the applicant, and therefore, no such petition could possibly have cited the RCE as a basis for withdrawal pursuant to 37 CFR 1.313(c)(2). The withdrawal from issue was done at the initiation of the Office, not the applicant, and therefore must satisfy the requirements set forth under 37 CFR 1.313(b).

The Office Action Summary form further states that the Office Action is “Responsive to communication(s) filed on 06/20/2005”, however, in the “Response to Arguments” section of the Office Action, the Examiner states, “Applicant’s arguments filed 08/30/2004 have been fully considered but they are moot in view of a new ground of rejection”, (Office Action, page 9, section 25). This entry is confused and irrelevant to the issue of proper withdrawal from issue. First, there were several intervening communications between the “08/30/2004” response and the March 27, 2006 office action, including a non-final office action mailed on October 10, 2004 and applicants response mailed on January 19, 2005. The claims listing contained in the January 19, 2005 response were subsequently allowed by examiner in the Notice of Allowance mailed on March 17, 2005. Therefore, the March 27, 2006 office action cannot be properly in response to applicant’s “08/30/2004” response.

Regarding applicants' June 20, 2005 communication, the only arguments submitted were in support of non-substantive, corrective amendments to the drawings, not touching on the allowed claims whatsoever. The March 27, 2006 Office Action, allegedly in response to the June 20, 2005 communication, did not discuss or touch on the contents of the drawing amendments submitted by applicant on or around June 20, 2005 at all, and so cannot be reasonably construed as a response to those drawing amendments. Therefore, Examiner's response in the Office Action mailed March 27, 2006 to arguments submitted on "08/30/2004" are errant, do not consider intervening office actions and applicant responses, and more importantly, does not establish a determination of unpatentability of allowed claims *prior to, and sufficient to form the property basis for*, withdrawal from issuance under 37 CFR 1.313(b) in January of 2006.

Lastly, the rejection of claims in the March 27, 2006 Office Action itself does not constitute either required notification of the conditions forming the basis for a proper withdrawal from issuance under 37 CFR 1.313(b), nor does it establish that the unpatentability of one or more of the claims was determined *prior to and as a proper basis for* the withdrawal from issuance, as is required under MPEP 1308, §II and discussed above. The rejection does not constitute the required notification because the Office Action does not state in any reasonably understandable manner that the rejections in the Office Action are to, or should be construed to form the basis for the withdrawal from issuance. Therefore, as mentioned, the office action fails to comply with MPEP 1308.01, and fails to provide sufficient notification under the requirements of 37 CFR §1.313(b).

The Office Action states that applicant's arguments are "moot in view of a new ground of rejection". As shall now be discussed, the record shows that the new ground for rejection was

determined *after* the withdrawal from issue, not before withdrawal as is required under 37 CFR §1.313(b).

The new ground of rejection under 35 USC §102, asserted in the March 27, 2006 Office Action, is a patent to Matsushima (US 6,232,652). However, the Image File Wrapper located on the USPTO PAIR shows that the Examiner conducted an EAST Search on March 2, 2006 including Classes 257 (subclasses 683, 778, and 796) and 438 (subclasses 108 and 124)('Part of Paper No. 20060302'). This entry in PAIR is dated March 27, 2006; the same date that the Office Action was mailed. The Image File Wrapper also shows an entry dated March 27, 2006, including a 'Notice of References Cited' indicating one reference, Document Number 'US 6,232,652' to Matsushima, Hironori, found under classification 257. This is the same classification searched on March 2, 2006 by the Examiner, and is the same reference used by the Examiner as the basis for each and every rejection in the Office Action.

Therefore, the record indicates that the examiner searched for and found the reference used in the Office Action almost *two months after* the withdrawal from issuance. This is clearly improper, and cannot form the basis for a proper withdrawal from allowance as set forth in 35 USC §151, 37 CFR §1.313(b), and MPEP 1308, §II. A determination of unpatentability of one or more of the allowed claims, initiated by the Office after payment of the issue fee by the applicant, must be established *prior to* withdrawal from issue, and as clearly stated in MPEP 1308 and discussed above; "Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee at the initiative of the Office are . . . (B) to permit the examiner to consider whether one or more claims are unpatentable". The EAST search subsequent to the withdrawal from issue, and the fruits of that search, the Matsushima patent, permitted the examiner to consider the patentability of one or more of the allowed claims, and

was subsequently used to reject the claims in an Office Action following withdrawal from issue. The Notice indicated that the reasons for withdrawal would be communicated by the Examiner. Because the Examiner failed to provide any explicit communication of such, applicants can only reasonably infer that the rejections themselves were intended to constitute such “communication”. However, as the record and the Office Action show, because the search and reference forming the basis for the rejections took place after the withdrawal from issue, the rejections cannot form a proper basis for withdrawal from issue under 35 USC §151, 37 CFR §1.313(b), and MPEP 1308, §II.

Summary

Because a 37 CFR §1.313 Withdrawal from Issue after payment of the issue fee by the applicant can only be proper under sections 37 CFR §1.313(c) or 37 CFR §1.313(c), and the requirements of these sections were not met by the Office, the Withdrawal from Issue of applicants’ patent application was improper, as explained and established in detail above.

A petition for withdrawal from issue was not submitted by applicants, so the withdrawal cannot be a withdrawal under 37 CFR §1.313(c). The office has not established that the withdrawal is based on any of the conditions required under 37 CFR §1.313(b)(1), (2), or (4), so could only possibly be asserted under 37 CFR §1.313(b)(3), unpatentability of one or more of the allowed claims. No such unpatentability was asserted in the Notice, and the search yielding the reference asserted in the March 27, 2006 Office Action took place *after* the withdrawal from issue, strongly indicating that the determination of unpatentability by the Office arose *after* withdrawal, not before withdrawal as *required* under 37 CFR §1.313(b). Therefore, the Withdrawal from Issue was improper, and applicants are entitled to an adjustment of patent term because the Office failed to issue a patent on an application within four months after payment of

the issue fee and satisfaction of all outstanding requirements per 35 USC §154(b)(1)(A)(iv) and 37 CFR §1.702(a)(4).

Relevant Dates as Specified in 37 CFR §§1.703(a) through (e)

The filing date for applicants' application is December 29, 2000, and the application is not based on a previously filed provisional application, nor is it a continuation or divisional application based on a separate parent application. Therefore, a term of a patent issued on the application, prior to any adjustment granted pursuant to this application for patent term adjustment, would extend twenty years from the filing date of December 29, 2000, until December 29, 2020.

Adjustment Specified in 37 CFR §1.703(f) to Which Patent is Entitled

Because the Withdrawal from Issue was improper, applicants assert entitlement to a patent term adjustment consisting of the number of days beginning October 17, 2005, and ending on the date that a patent is issued on the allowed claims. Because the applicant does not yet know when the application will finally issue, applicant cannot yet calculate the exact number of days of patent term adjustment under applicants' claim of right. Applicants claim entitlement under 35 USC §154(a)(2), §154(b)(1)(A) (specifically §154(b)(1)(A)(iv)), and 37 CFR §1.703(a)(6). As specified under §154(b)(1)(A), "the term of the patent shall be extended 1 day for each day after the end of the period specified in clause . . . (iv), as the case may be, until the action described in such clause is taken.

Should the Office deny applicants' application for patent term adjustment under the claim of right, applicants alternatively assert entitlement to a patent term adjustment consisting of the

number of days beginning October 17, 2005, and ending when a patent is issued on the application, minus the number of days between (a) the mailing date of the March 27, 2006 Office Action and the mailing date of applicants' April 27, 2006 response thereto (31 days total) , and (b) the mailing date of the May 18, 2006 Notice of Allowance and the submission date of applicants' Form 85B 'payment' of the issue fee. The remaining days constitute delays entirely attributable to the Office.

Patent NOT Subject to Terminal Disclaimer

Applicants submit that the application is not subject to a terminal disclaimer.

There are no Circumstances Constituting Failure to Engage in Reasonable Efforts to Conclude Processing or Examination

Applicants respectfully submit that there are no circumstances constituting failure to engage in reasonable efforts to conclude processing or examination. The failure to issue a patent forming the basis for right to patent term adjustment under 37 CFR §1.702(a)(4) took place after the closure of examination, and after the applicants had paid the issue fee and satisfied all outstanding requirements. The applicants had only to wait for the Office to issue a patent based on the application. Therefore, the failure of the Office to issue a patent as required under 35 USC 151 and 35 USC §154(b)(1)(A)(iv) did not in any way result from a failure on the part of the applicants to engage in reasonable efforts to conclude processing or examination.

CONCLUSION

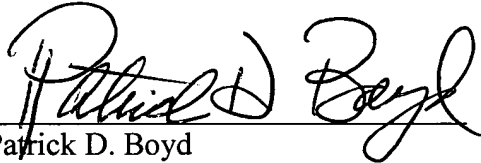
In light of the points and arguments set forth herein, applicants respectfully request that the Office grant applicants' application for an adjustment of patent term for a patent granted on this application. Applicants respectfully submit that the correct patent term adjustment under 35 USC §154(b)(1)(A) and 37 CFR §1.703(a)(6), with regard to 37 CFR §1.702(a), is the number of days beginning on October 17, 2005, four (4) months after the issue fee was paid and all outstanding requirements were satisfied, and ending on the issue date of a patent on the allowed claims.

Please charge any shortages and credit any overages to Deposit Account No.

02-2666.

Respectfully submitted,

Date: August 2, 2006


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